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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,435	12/05/2003	Nicholas R. Baumann	55457US029	9401

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EXAMINER	
WALCZAK, DAVID J	
ART UNIT	**PAPER NUMBER**
3751	

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/728,435	BAUMANN ET AL.	
	Examiner	Art Unit	
	David J. Walczak	3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/5/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Abstract

The abstract of the disclosure is objected to because phrases which can be implied, such as "are disclosed" should not be present therein. Correction is required. See MPEP § 608.01(b).

Specification

The disclosure is objected to because of the following informalities: Page 1 of the specification should be amended to indicate that 10/123,325 is now U.S. Patent Number. 6,672,784. Appropriate correction is required.

Claim Objections

Claims 47 and 48 are objected to because of the following informalities: On the last line of claim 47, it appears that the ";" should be a --.--. Further claims 47 and 48 are identical to claims 26 and 27, respectively. Appropriate correction is required.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-13, 16-19, 21-25 and 28 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6, 10, 11, 13-17, 21-27 and 30-32 of prior U.S. Patent No. 6,422,778. This is a double patenting rejection.

Claims 29-37, 39-41, 43 and 44 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-9 and 11-15 of prior U.S. Patent No. 6,672784. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 26, 27, 42, 45 and 46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14, 16 and 17 of U.S. Patent No. 6,672,784. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims anticipate the pending claims and anticipation is the epitome of obviousness.

Claims 15, 20, 26, 27 and 47-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32 and 33 of U.S. Patent No. 6,422,778. In regard to claims 26, 27, 47 and 48, although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims anticipate the pending claims and anticipation is the epitome of obviousness. In regard to claims 15, 20 and 49-51, '778 discloses all of the claimed steps except for the sterilizing of the various elements. The Examiner takes official notice that surgical instruments are commonly sterilized prior to use in order to render the device safe and not infect a patient with a dirty device. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to sterilize the device claimed in the '778 reference in order to render that device safe to use.

Claim Rejections - 35 USC § 112

Claims14 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In regard to claim 14, an antecedent basis for "the spout" (line 1) should be defined. In regard to claim 38, an antecedent basis for "the flow restrictor" should be defined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 42 is rejected under 35 U.S.C. 102(b) as being anticipated by Sutton et al. (hereinafter Sutton). Sutton discloses an applicator system for applying surgical prep solution comprised of a collapsible container 110 (see column 5, lines 1-4) comprising a surgical prep solution (see column 2, lines 59-67) and a spout 16 and a spreader element comprised of a body 82 having an orifice 60, a pad 80 attached to the body over the orifice and a stem 30 having a distal end attached to the body and a passage 32 comprising a flow restrictor (both elements 42 and the passage itself define a flow restrictor) wherein the proximal end of the stem is attached to the spout such that the passage is in fluid communication with the orifice and the container and flow of the solution is restricted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 26, 27, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vosbikian et al. (hereinafter Vosbikian) in view of Gordon et al. (hereinafter Gordon). In regard to claims 26 and 47, Vosbikian discloses an applicator system comprised of a container 2 and a spreader element 3 comprised of a body 17 having an orifice 16, a pad 20 attached to the body over the orifice, a stem 13 having a distal end attached to the body and a passage extending therethrough and in fluid communication with the orifice at the distal end thereof and a receptacle 14, 15 at the proximal end of the stem and extending around a portion of the circumference of the container when the container is attached to the spreader. In regard to claims 27 and 48, the receptacle 14,15 extends around only a portion of the circumference of the container. Although the Vosbikian reference does not disclose that the container includes surgical prep solution therein, attention is directed to the Gordon reference, which discloses another hand held pad-type applicator wherein the applicator is used to apply surgical prep solution (see the Abstract) in order to enable a user to conveniently apply such a solution to a patient. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Vosbikian device to dispense surgical prep solution in order to enable a user to conveniently apply said solution, especially since the Vosbikian reference does not limit the material that can be dispensed (see column 1, lines 37-40 and 50-56).

Claims 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutton. Although the Sutton reference does not disclose the specific type of prep solution, it is the Examiner's position that any suitable and known prep solution,

including the claimed solution, can be used in the Sutton device without effecting the overall operation of the device.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Laughlin reference is cited for disclosing another cleaning device wherein a receptacle partially covers a collapsible container.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-5895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David J. Walczak
Primary Examiner
Art Unit 3751

DJW
6/8/05